

### **REMARKS**

Claim 13 is amended above. New claim 21 is added. Applicant respectfully requests reconsideration of this application.

#### **The objection to claim 11 can be withdrawn.**

Applicant believes that the objection to claim 11 was actually intended to be an objection to claim 13. The language “non-adjacent tension members” does not appear in claim 11 but does appear in claim 13. Applicant has amended claim 13 in view of the Examiner’s comments. Applicant respectfully submits that the objection can be withdrawn.

#### **The rejection of claims 1, 3, 8, 9, 15-17 and 20 under 35 U.S.C. §103 should be withdrawn.**

Applicant respectfully submits that there is no *prima facie* case of obviousness. The Examiner proposes to modify the *Clarke* reference with teachings from the *Crick* reference. There must be a legally sufficient reason for such a modification. When the teachings of the secondary reference do not provide any benefit in the context of a primary reference, that reason is missing and there is no *prima facie* case of obviousness. The proposed combination cannot be made. In terms of the recent Examiner Guidelines regarding the obviousness inquiry, there is no predictable result.

In this instance, the teachings of the *Crick* reference do not provide any benefit in the context of the *Clarke* reference because the condition being addressed by the *Crick* reference will not occur in the *Clarke* reference. The *Crick* reference is directed to locating a fault that is a short between two conductors. There will not be any such condition in the *Clarke* reference. That reference teaches that the tensile members 10 are separated by the elastomeric body because the “tensile cords 10 are embedded in elastomeric material 11 in such a way so as to prevent contact between adjacent cords 10 along the length of the belt.” (Paragraph 15, lines 3-6) Each

end of the tensile cords are connected to the next cord to form a series circuit (paragraph 16, lines 1-2). Given that the tensile cords in the *Clarke* reference are already connected to each other at the ends, there is no concern with identifying a short between them because they are already connected to each other.

The techniques disclosed in the *Crick* reference are for locating a short between two conductors. Given that there is no need for any such location technique in the *Clarke* reference, the proposed modification does not provide any benefit and, therefore, the legally required reason for making the modification is missing. There is no *prima facie* case of obviousness.

Further, the *Clarke* reference is concerned with noticing changes in resistance associated with changes in strain on the tensile cords of *Clarke's* belt. The *Clarke* reference relies upon connecting the different tensile cords together to form a series circuit. A short between any of those tensile cords (however extremely unlikely because of the elastomeric material between them) will not have any affect on the tension on those cords and will not affect the resistance. Further, any short in the *Clarke* reference will not change the ability of the *Clarke* reference to achieve its intended result of monitoring resistance.

Lastly, there would be no benefit to locating a short in the *Clarke* reference. That is the entire purpose of the teachings of the *Crick* reference. Locating a short in a belt of the *Clarke* reference does not provide any benefit. If the resistance measurements obtained in the *Clarke* reference indicate that something should be done regarding the condition of the belt, the entire belt is going to be replaced. There is no need to identify the location of a short using the techniques of the *Crick* reference.

It follows that the teachings of the *Crick* reference do not have any relevance or usefulness in the context of the *Clark* reference. There is no benefit from making the proposed

modification. Therefore, there is no predictable result and the combination cannot be made. There is no *prima facie* case of obviousness and the rejection should be withdrawn.

**The rejection of claims 2, 7, 10, 14 and 18  
under 35 U.S.C. §103 should be withdrawn.**

Applicant respectfully traverses this rejection for the same reasons given above. The base combination of the *Clarke* and *Crick* reference cannot be made. Therefore, there is no *prima facie* case of obviousness regardless of what the *Robar* reference actually teaches.

Further, Applicant respectfully submits that the *Clarke* and *Crick* references teach away from the Examiner's proposed modification. The *Clarke* reference teaches that the tensile cords are connected together in series. Therefore, a signal applied to one of the tensile cords is going to be applied to all of them. This feature of the *Clarke* reference teaches away from the Examiner's proposed modification of applying the signal to only one of the tension members at a time.

Further, the *Crick* reference requires that two conductors (between which there is a short that the *Crick* reference is trying to locate) both receive the current at the same time. The arc that is produced in the *Crick* reference can only be produced if current is supplied to both conductors at the same time.

Given that the *Clarke* and *Crick* references both teach away from the Examiner's proposed modification, the legally required reason for making it is missing and there is no *prima facie* case of obviousness.

Additionally, it is not possible to modify the teachings from the *Crick* reference in a manner that would apply current to only one of the two conductors because that would entirely change the principle of operation of that reference and would defeat its ability to achieve its intended result. Such modifications cannot be made for purposes of attempting to manufacture a

*prima facie* case of obviousness. MPEP 2143.01(V) and (VI) are instructive on this point. There is no *prima facie* case of obviousness and the rejection should be withdrawn.

**The rejection of claims 4, 5, 11, 12 and 19  
under 35 U.S.C. §103 should be withdrawn.**

As explained above, the proposed base combination of the *Clarke* and *Crick* references cannot be made. There is no predictable result. The proposed addition of teachings from the *Brucken* reference does not remedy that defect and there still is no *prima facie* case of obviousness. The rejection should be withdrawn.

**Conclusion**

Applicant is grateful for the indication of allowable subject matter. For the reasons given above, Applicant respectfully submits that all claims are allowable.

Applicant believes that fees in the amount of \$52.00 are required for one claim in excess of twenty. The Commissioner is authorized to charge the credit card in the name of U.S. Patent and Trademark Office, c/o Otis Elevator Company, in the amount of \$52.00. The Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

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